



UNITED STATES PATENT AND TRADEMARK OFFICE

67

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,969	01/25/2002	N. Leigh Anderson	41550	4003

27860 7590 07/05/2005

LARGE SCALE BIOLOGY CORPORATION
3333 VACA VALLEY PARKWAY
SUITE 1000
VACAVILLE, CA 95688

EXAMINER

CHIN, CHRISTOPHER L

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,969

Applicant(s)

ANDERSON ET AL.

Examiner

Christopher L. Chin

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9 and 46-50, drawn to a fiber bundle, classified in class 422, subclass 50.
 - II. Claims 10-15, drawn to a method for forming a fiber bundle, classified in class 435, subclass 4.
 - III. Claims 16-18, drawn to a method of making an array, classified in class 435, subclass 4.
 - IV. Claims 19-21, drawn to an array, classified in class 422, subclass 55.
 - V. Claim 22, drawn to an array, classified in class 422, subclass 57.
 - VI. Claim 23, drawn to an array, classified in class 435, subclass 287.1.
 - VII. Claim 24, drawn to an array, classified in class 435, subclass 287.2.
 - VIII. Claims 25-26, drawn to a method of assay, classified in class 436, subclass 518.
 - IX. Claims 27-28, drawn to a method of assay, classified in class 436, subclass 518.
 - X. Claim 29, drawn to a method to detect alignment of fibers in a bundle, classified in class 356, subclass 73.1.
 - XI. Claims 30-31, drawn to a microarray, classified in class 422, subclass 55.
 - XII. Claims 32-33, drawn to a microarray, classified in class 422, subclass 57.

Art Unit: 1641

- XIII. Claims 34-35, drawn to a microarray, classified in class 435, subclass 287.1.
- XIV. Claims 36-37, drawn to a microarray, classified in class 435, subclass 287.2.
- XV. Claims 38-39, drawn to a multiwell plate, classified in class 422, subclass 58.
- XVI. Claims 40, 44, and 45, drawn to a thin elongated fiber and cross section, classified in class 385, subclass 12.
- XVII. Claim 41, drawn to a solid phase construct, classified in class 435, subclass 287.1.
- XVIII. Claims 42-43, drawn to a microarray with a porous particle, classified in class 422, subclass 58.
- XIX. Claims 61-65, drawn to a method of forming a fiber bundle, classified in class 435, subclass 4.
- XX. Claims 66-70, drawn to a microarray, classified in class 422, subclass 55.
- XXI. Claims 71-73, drawn to a microarray, classified in class 422, subclass 50.
- XXII. Claims 74-79, drawn to a method of manufacturing a microarray, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions IV-VII, XI-XVIII, XX, and XXI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04,

Art Unit: 1641

MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation as shown by the different components that comprise each of the products in Groups IV-VII, XI-XVIII, XX, and XXI.

3. Inventions VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation since the methods of assay in each group use different arrays.

4. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the method of Group XIX.

5. Inventions I and XIX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

Art Unit: 1641

that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the method of Group II.

6. Inventions X and I-IX and XI-XXII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects since the method of Group X is not required for the products and methods of Groups I-IX and XI-XXII.

7. Inventions IV, XI-XIV, XVIII, XX, XXI and III, XXII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products of Groups IV, XI-XIV, XVIII, XX, XXI can be made by another and materially different process such as either of the methods in Groups III or XXII.

Art Unit: 1641

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and the search required for each of Groups I-XXII is distinct, requiring different search terms and different search strategies on commercial data bases, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

Art Unit: 1641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin
Primary Examiner
Art Unit 1641

6/27/05